

Item 1 of the Office Action rejects claims 1-4, 7, 12-14, 17 and 22-44 under 35 USC §103(a) over U.S. Patent 5,325,765 to Sylvan in view of U.S. Patent Publication 2002/0185010 to Spiteri. Item 2 of the Office Action rejects claims 3, 5, 6, 9-11, 15, 16, 19-21 and 32 under 35 USC §103(a) over Sylvan in view of Spiteri and further in view of U.S. Patent 3,971,305 to Daswick. Item 3 of the Office Action rejects claims 8 and 18 under 35 USC §103(a) over Sylvan in view of Spiteri and further in view of U.S. Patent 3,389,650 to Michielsen.¹ These rejections are respectfully traversed.

In rejecting independent claims 1, 12 and 44, the Office Action indicates that it would have been obvious to one of ordinary skill in the art to modify the Sylvan cartridge to use a pleated or fluted filter, as taught by Spiteri, “in order to further augment the self-supporting aspect of the filter.” The Office Action also indicates that “[i]t would have also been expedient to manufacture the filter element of Sylvan with the pleats/flutes of Spiteri to facilitate handling and packaging, cost-effective production, and provide stiffness so as to ensure sufficient rigidity to avoid collapse or sagging when wetted, as explained at paragraphs 6 and particularly 7 of Sylvan.” (Office Action, page 5, lines 1-5)

As detailed in Section 8 of the attached second Declaration Under Rule 132 dated Nov. 21, 2007 (Declaration), the reasons articulated in the Office Action why it would have been obvious to one of ordinary skill in the art to make the asserted modification are technically inaccurate. For example, the Declaration details why the Spiteri filter is not self-supporting in a way that makes it suited for use in a Sylvan cartridge. Although Spiteri uses the phrase “self-supporting” in reference to the filter, the nature of the self-supporting aspect of the Spiteri filter is quite different from that of the filter in the Sylvan cartridge. The Spiteri filter is supported from the bottom in a brew basket, and the Spiteri filter sidewalls are self-supporting in the sense that they will not sag downwardly due to the pull of gravity when wetted. (Spiteri paragraphs 0002, 0003, 0007 and 0008). In Sylvan,

¹ Item 3 of the Office Action refers to WO91/14389 as being attributed to Spiteri, when in fact, it should be attributed to Frise. Applicant understands this indication to be to the Spiteri reference. Items 2 and 3 of the Office Action also refer to “Lesser” and “Tanner”, both prior applied references like Frise. Since no formal rejection of claims is made in view of these references (and prior rejections based on them have been withdrawn), Applicant assumes these indications to be typographical errors.

the filter is suspended at the cartridge container sidewall from the filter top edge. Thus, the filter hangs in the container and there is no concern that the top edge of the filter will sag downwardly due to the pull of gravity. The Sylvan filter must be self-supporting in the sense that it does not contact the container sidewalls when wetted and/or with the introduction of pressurized water into the cartridge. (Sylvan col. 2, lines 3-7 and col. 3, lines 10-13, for example). This is not a concern for the Spiteri filter, which is supported by the brew basket at least at the filter bottom, and likely the sides when the filter is filled with coffee grounds and water. Therefore, just because both Spiteri and Sylvan use the phrase “self-supporting” does not necessarily mean that the Spiteri filter would be suitable for use in the Sylvan cartridge. In fact, the Declaration describes that one of skill in the art would have expected the pleated Spiteri filter to be radially compliant, resulting in the filter contacting the container walls during brewing if used in a Sylvan cartridge – a condition expressly taught to be avoided by Sylvan.

The Declaration also details the reasons why the use of a Spiteri-type filter in the Sylvan cartridge would not be an expedient to manufacture, would not facilitate handling or packaging and would not be more cost-effective. The Declaration makes it clear that one of ordinary skill in the art would have viewed the more complicated filter arrangement of Spiteri to make manufacture of a Sylvan cartridge more complicated, and thus more expensive. As for facilitating packaging, once the Sylvan cartridge is made, it is not folded or otherwise configured for packaging purposes, as discussed in Spiteri at paragraph 0007. Thus, the “packaging” advantages touted in Spiteri are not relevant to a Sylvan cartridge.

In short, and as described in the Declaration, the use of a fluted or pleated filter in a Sylvan cartridge does not involve the combination of known elements according to known methods so as to yield predictable results. The results in using of a fluted or pleated filter in a Sylvan cartridge would not have been predictable to one of ordinary skill in the art, mainly because a fluted or pleated filter had no known functional use in a pressurized cartridge brewing arrangement like that of Sylvan. As discussed in the Declaration, the function of a filter in a drip-type brewer is not the same as the function of a filter in a cartridge like that of Sylvan. Thus, one of skill in the art would not have had a reasonable expectation of success in using a fluted or pleated filter in the

Sylvan cartridge. For example, although Spiteri indicates that the pleated filter is relatively rigid in a vertical direction, no mention is made regarding the filter's radial rigidity. One of ordinary skill in the art would have understood that the relative flexibility of the Spiteri filter in the radial direction would make the filter expand when subjected to the injection of pressurized water into the interior of the filter (e.g., in a way similar to that when the filter is unfolded and expanded for placement in a brew basket) – causing the filter to potentially contact the container sidewalls. This is in direct contradiction to the teaching of Sylvan that the filter should not contact the container sidewalls. Accordingly, one of skill in the art would not have expected a fluted or pleated filter to function properly in a Sylvan cartridge. The substitution of a fluted or pleated filter for the conical filter of Sylvan is not the simple substitution of one known element for another so as to obtain predictable results, e.g., because there would not have been a reasonable expectation of success in making the substitution. Also, nothing in the applied art suggests that the use of a fluted or pleated filter in the Sylvan cartridge would have improved the function of the cartridge or any other aspect of its use, manufacture or other feature. The Office Action has also not articulated any viable design incentive or other market force that would have prompted one to make the asserted modification.

In view of the foregoing and the attached Declaration, Applicant respectfully submits that the §103 rejections of claims 1-44 are improper, e.g., because the purported reasons why one of skill in the art would have made the asserted modification of the Sylvan cartridge are inaccurate. Applicant respectfully requests that these rejections be withdrawn.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

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Respectfully submitted,

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